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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,341

03/29/2004

Thomas J. Perkowski

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EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

03/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/812,341	<b>Applicant(s)</b> PERKOWSKI ET AL.	
	<b>Examiner</b> Jeffrey D. Carlson	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31,32,34-38,40,42,43,45,46,48-52,54,56 and 57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31,32,34-38,40,42,43,45,46,48-52,54,56 and 57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. This action is responsive to the paper(s) filed 12/15/2008.

### ***Double Patenting***

2. Applicant has created quite a tangled web of similarly-focused pending applications, many of which are being examiner by this examiner. There appears to be no apparent rhyme or reason why so many applications are copending, nor any focus on any particular inventive twist or direction specific to each case, thus failing to create a clear line of demarcation between the applications. See MPEP § 822. For this reason, there are an overwhelming amount of overlapping claims and concepts which are subject to the following double patenting issues.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 31-32, 34-38, 40, 42-43, 45-46, 48-52, 54, 56-57 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the following claims of the following copending applications.

<u>Application</u>	<u>Claims</u>
11/804769	1-19
10/876261	154-170
10/059078	49-58
10/602990	63-107
10/693856	63-70,72,74,75,77-85,87 and 88
11/823828	8-21, 37-53
10/059076	78-99
10/058970	98-115
09/695744	478-489
09/716848	497-507
10/059076	78-99
10/058970	98-115
09/695744	478-489

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31-32, 34-38, 40, 42-43, 45-46, 48-52, 54, 56-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 31-58 are system (apparatus) claims, yet they include many features which are presented as method steps rather than capabilities, rendering the

claim scope uncertain. In these computer-based system claims, the best way to set forth apparatus structure is to claim *capabilities* of the apparatus by stating an element/module/subsystem is *programmed to <perform an act>* OR is *configured to <perform an act>*, rather than claiming the element actively performs the act. Exemplary, but not exhaustive examples are as follows:

- Claim 31, 45 - products which are offered for purchase and sale by...a payment method; offered for purchase and sale (second appearance on pg 4); said first internet-enabled information server generates and serves; web browser displays a GUI; browser of a consumer processes said MMVK tag; said first internet-enabled information server automatically executes...and generates and serves; said MMVK automatically plays; inviting and allowing the consumer to review and interact.
- Claim 40, 54 - browser is responsive to the consumer clicking; it is further not clear whether applicant is attempting to actually claim the user's web browser as part of the apparatus claim – and if so, what browser capability is being claimed? If not, it is unclear in what way the apparatus/system is being further limited. Is this a method step? What feature of the system is being further defined here?
- Claims 32, 45 - so as to help analyze effectiveness; is there a programmed capability present to accomplish this effectiveness analysis?

Capabilities to measure and report interactions may not be representative of “analysis”.

- Claim 38, 52, there is no antecedent basis for said set of display attributes.
- Claim 46 appears to repeat the features already present in claim 45, leading to confusion in the claim scope of 45 and 46.
- Claims 31, 45, the “and/or” renders the claim scope uncertain.
- Claims 34 and 48 depend from canceled claims, thereby rendering their scope uncertain.
- Claim 56, there is no antecedent basis for TM or PD.

### ***Allowable Subject Matter***

5. As best understood, claims 31-32, 34-38, 40, 42-43, 45-46, 48-52, 54, 56-57 appear to be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc